

USPTO Customer No. 25280

Case No. 5635

REMARKS

The applicants thank the Examiner for her kind assistance and thoughtful consideration of this application.

It is requested that these claim amendments, which present the claims in better form for appeal, be entered in this application. Even if the Examiner does not grant the request below to withdraw the Final Action and fully consider these arguments (see below), applicant still requests that these amendments be entered after final for purposes of appeal, pursuant to 37 CFR Section 1.116.

Pending Claims

Claims 1-5 and 7-14 and new claims 34, 35 are pending. Claims 6 and 15-33 have been canceled without prejudice or disclaimer.

Applicant in the past has overcome previous prior art rejections, and also the issues with regard to section 112. But, in the recent Office Action, a new reference was cited against the application, U.S. Patent No. 4,617,208 to Cadenhead (the "Cadenhead patent" or "Cadenhead reference"). Although the Cadenhead reference was known to the Examiner (i.e. it was cited by the examiner in the list of references in the Office Action of 5/11/2007), no rejection was made on Cadenhead in a previous Action. But, the claims now are rejected in light of Cadenhead pursuant to sections 102(b) and 103(a).

Premature Final Rejection

This is a premature final rejection. Applicant requests that the final be withdrawn, and these amendments and comments considered for all purposes, before issuance of the next Office Action. Section 706.07(a) of the MPEP indicates that

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second or subsequent actions cannot be final in cases for which the examiner introduces a new ground of rejection. This Cadenhead rejection is a new ground of rejection.

An exception to this rule is in the instance in which applicant's amendment necessitates (forms the basis of) the new rejection. In this instance, the exception does not apply. The amendments made previously related to adding a process step of heating the tufts with non-textured fibers to a temperature above the glass transition temperature of the fibers. There is no technical basis for a finding that such amendment "necessitated" the sudden rejection based upon this new Cadenhead reference. There is nothing about Cadenhead or its teachings that would give any special significance to applicant's prior amendment. There is simply no connection between the amendment and the citing of Cadenhead. Since applicant's amendment did not necessitate a rejection based upon Cadenhead, then the final rejection should be withdrawn, and this amendment should be considered as if in response to a non-Final rejection.

Even if the Examiner does not grant the request below to withdraw the Final Action and fully consider these arguments, applicant still requests that these amendments be entered after final for purposes of appeal, pursuant to 37 CFR Section 1.116.

*The Rejection Under
Section 102 in Light of Cadenhead*

The rejection under section 102 should be withdrawn. The amended claims require "knitting the pre-stressed polyester yarn together in a single fabric forming

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operation". Cadenhead does not teach knitting a pre-stressed polyester yarn together in a single fabric forming operation.

The present invention claims a product. The product is a non-tufted knitted fabric. Cadenhead does not teach the manufacture of a non-tufted knitted fabric product. Instead, Cadenhead teaches a tufted carpet.

Cadenhead specifically teaches using two successive fabric forming operations. Cadenhead teaches the manufacture of synthetic outdoor carpeting. It discloses ribbon fibers, which resemble grass blades. The embodiments disclosed in Cadenhead (columns 5 and 6) relate to fibrillated, green, continuous filament polypropylene ribbon. This polypropylene ribbon is knitted in a first fabric forming operation. Then, the polypropylene continuous filament material is heated, cooled, and deknitted (taken apart), to form yarn that is wound upon cones. The de-knitted yarn is then used in a tufting machine to make tufted polypropylene carpet in a second forming operation. The backing into which the de-knitted polypropylene yarn is made of woven polypropylene.

*The Rejection Under
Section 103 in Light of Cadenhead*

The claimed invention is not obvious in light of Cadenhead. The device used in the Cadenhead prior art is a fibrillated, green, continuous filament polypropylene ribbon. This polypropylene ribbon is knitted in a first fabric forming operation. Then, the polypropylene continuous filament material is heated, cooled, and deknitted (taken apart), to form yarn that is wound upon cones. The de-knitted yarn is then used in a tufting machine to make tufted polypropylene carpet in a second forming operation. The backing into which the de-knitted polypropylene yarn is made of woven

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polypropylene. Thus, the disclosed product of the prior art Cadenhead is a polypropylene outdoor type carpeting with tufts that are contorted due to memory of being knitted, and then de-knitted (two fabric forming operations).

*The Product is
Distinguished from the Prior Art*

Cadenhead has no enabling disclosures showing the use of non-textured polyester yarn. The fact that Cadenhead may contain "global" language of other types of materials is not relevant. There is no disclosure in Cadenhead of a manner of making such a product using polyester as a starting material. It is known that the behavior of polypropylene and polyester are very different. There is no reason to assume that these materials will behave the same, in fact, there is reason to doubt that one can simply switch the material and obtain identical results.

Further, Cadenhead offers no teaching of pre-stressed polyester yarn. Cadenhead does not offer a mechanism other than knitting followed by deknitting, for obtaining its effects. There is no disclosure of pre-stressing polyester yarn in Cadenhead. Further, there is no teaching in the prior art that would lead one to abandon the de-knitting of Cadenhead for some other manner of making the artificial turf grass disclosed by Cadenhead.

The claims at issue are directed to continuous filament non-textured polyester yarn. This distinguishes the claimed invention from the Cadenhead prior art without reliance on any process-type feature. The limitation POLYESTER clearly is not a process limitation, and as such, there is no valid objection to the claim as obvious using the theory of *In re Thorpe*. In this instance, the product itself claimed patentably distinguishes over the prior art.

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The product claimed in applicants invention, regardless of the process, is still polyester. Further, applicants claimed invention is a completely nonobvious product, regardless of the process used to make the product. Thus, it is irrelevant the process whether the used to make the claimed product is patentable.

*For Hybrid Claims, Process
Limitations are Given Patentable Weight*

The claim should be read as a whole, and all limitations are given patentable weight. Every limitation positively recited in the claim must be given effect in order to determine what subject matter that claim defined. *In re Wilder*, 429 F.2d 447 (CCPA 1970).

The claim 1 recited above is actually a hybrid claim, and not a true product by process claim. A product by process claim is a product claim that includes significant and substantial process limitations. A true product by process claim is similar to that recited in *In re Thorpe*, cited in the Office Action. In *Thorpe*, the claim recited was the following:

"44. *The product of the process of claim 1*".

But, Claim 1 in *Thorpe* was the method claim. The method claim recites:

In the process of developing a metal-modified novolac phenolic resin wherein the metal is selected from the group consisting of copper, aluminum, zinc, chromium....the improvement comprising charging as reactants an oxide of the metal".

So, one can see that in the *Thorpe* case, this indeed was a true product by process claim, as traditionally defined. That is, the invention there was essentially totally defined by the method -- not the product. Then, the dependent claim was "the product" of the process which had been previously defined as a pure process.

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That is not the case here. This case is not like that in *Thorpe*. Here, we have what has been referred to as a hybrid claim. See Donner, *Patent Prosecution Practice and Procedure (3rd edition)*, Chapter 7 VIII, p. 882 (2003); see also *In re Johnson*, 394 F.2d 591 (CCPA 1968). Here, we have a product defined structurally as a device, but which contains a few limitations that describe in part features of how the product is made. That is a "hybrid" claim -- not the true "product by process" as defined in *Thorpe*.

In *In re Luck*, written by former Chief Judge Markey, it was held that a claim similar to that in this case (i.e. a hybrid claim) indeed was patentable. *In re Luck*, 476 F.2d 650 (CCPA 1973). In that instance, the examiner had rejected the claim, and did not consider as significant the process limitation stated in part (d) of the claim. The claim read as follows:

A hollow light transmitting lamp bulb-shaped glass member adapted to surround a source of radiations, a coating carried on the external surface of said glass member....

(d) said coating having been affixed to said glass member by applying thereon a liquid organic solvent having dissolved therein said polymer, said organofunctional silane and said additive organic substance, and said coated glass member thereafter being baked.

The CCPA held that it was error for the examiner to ignore the process limitation stated in part (d) of the claim. The Court said:

"As for the method of application, it is well established that product claims may include process steps to wholly or partially define the claimed product ... To the extent these process limitations distinguish the product over the prior art, they must be given the same consideration as traditional product characteristics."

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So, as indicated, the process of using a solvent was a feature (d) that the Court indicated must be considered in examination of the application. The claim in the current patent application for a non-tufted knitted fabric made of polyester yarn is comparable to the claim in *In re Luck*. That is, the claim to the product is primarily a product (device) claim, but with at least one claimed feature that is a method of making the product. This has been commonly called a hybrid claim. This is unlike the situation in *Thorpe*, which involved a pure process claims, and then a dependent claim which claimed "The product of the process in claim 1". This is not the *Thorpe* situation.

It has been stated that *In re Luck* is the leading decision in the area of hybrid claims. See Donner, *Patent Prosecution Practice and Procedure* (3rd edition), Chapter 7 VIII A, p. 885 (2003). Further, in the event of a conflict in cases, it is clear that the more recent case controls. *In re Gosteli*, 872 F.2d 1008 (Fed. Cir. 1989). The *Stephens* decision in the Office Action (see page 5 of the Office Action) is a CCPA decision dated 1965. On the other hand, the *In re Luck* case cited above is a CCPA case dated 1973. The *In re Luck* case, therefore, legally controls over the *Stephens* case on the issue of process-type features used in interpreting product claims having process features, for purposes of patentability.

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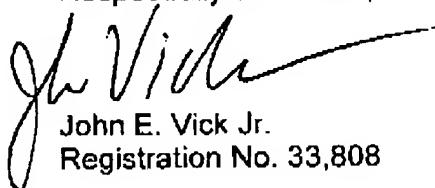
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Conclusion:

For the reasons set forth above, all claims are in condition for allowance.

In the event that there are additional fees associated with the submission of these papers (including extension of time fees), authorization is hereby provided to withdraw such fees from Deposit Account No. 04-0500.

Respectfully submitted,



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